

REMARKS

Claims 56, 69-71, 107, and 110-112 are pending. Claims 56 and 107 have been amended. Claims 110-112 have been added.

Objection under 35 U.S.C. §132

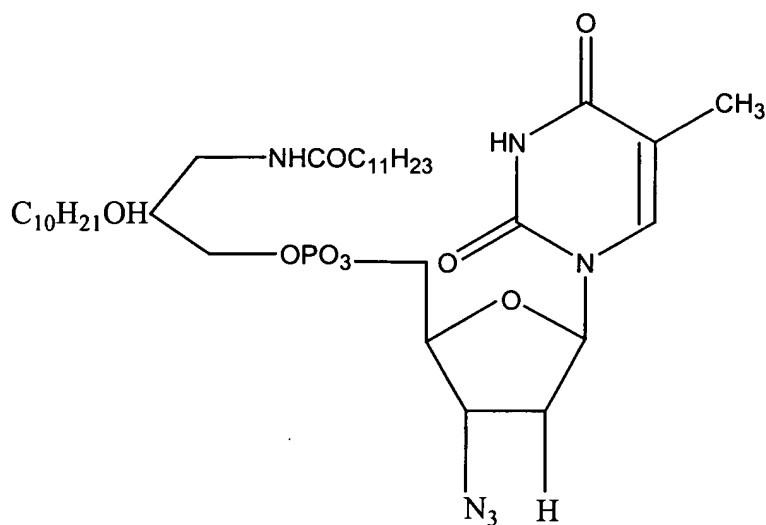
The amendments to the specification filed on February 7, 2003 were objected to under 35 U.S.C. §132 for introducing new matter into the disclosure. Applicants respectfully assert that the insertion of the oxygen atom between the P and Z atoms is not new matter and therefore the objection should be withdrawn.

It is well settled that amendments can be made to structural formulae to correct errors if there is sufficient evidence to show that the amended structure is an inherent characteristic of the subject matter. See, *Ex Parte et al.*, 27 U.S.P.Q.2d 1067 (CCPA 1993); *Ex Parte Marsili*, 214 U.S.P.Q. 904 (CCPA 1979); *Riester v. Kendall*, 72 U.S.P.Q. 481 (CCPA 1947); *In re Magerlein et al.*, 145 U.S.P.Q. 683 (CCPA 1965). In *Ex Parte Marsili*, an amendment made to the structural formula to correspond with the products described in the specification was not new matter. The Board stated that "the product, not the formula or name, is the invention." 214 U.S.P.Q. 906 (citing, *Petsi et al. v. Rennhard et al.*, 150 U.S.P.Q. 669 (CCPA 1966)). In addition, in *In re Oda*, if one skilled in the art would appreciate the nature of an error, correcting the error would not be an addition of new matter. 170 U.S.P.Q. 268 (CCPA 1971).

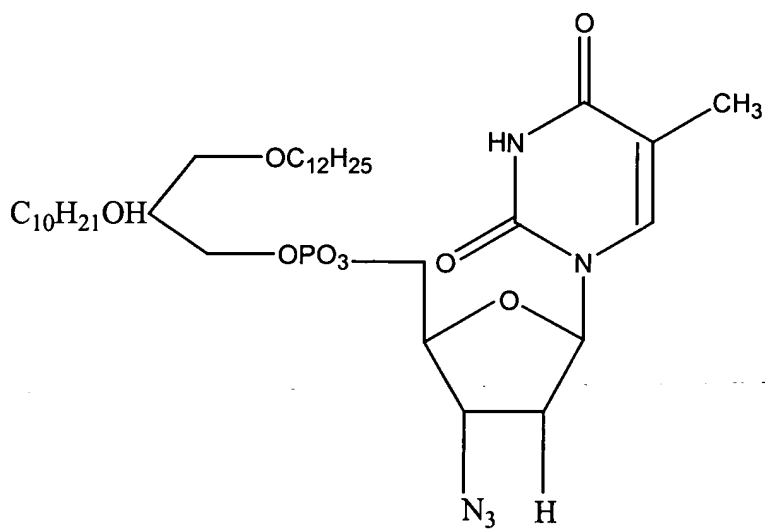
In this case, Applicants have amended Formula III in the specification to reflect the compounds of the invention claimed in claims 56, 69-71, 107 and 110-112 as well as other compounds described in the specification. These compounds, 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine and 3'-azido-3'-deoxy-5'-(dodecyoxy-2-decyloxypropyl)-phosphothymidine, are specifically disclosed in the specification on page 13, lines 1-2 and in Examples 5 and 6 on pages 21-23 and are of a structural formula that contains four oxygen atoms, not three, around the phosphorous atom.

The structures of these compounds are as follows:

3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine



3'-azido-3'-deoxy-5'-(dodecyoxy-2-decyloxypropyl)-phosphothymidine



As is clearly shown in the above structures, the specific disclosures of these compounds, as well as other exemplary compounds of Formula III as amended in the specification, are sufficient evidence to show that Formula III as amended is an inherent characteristic of these disclosed compounds. The omission of the oxygen atom in the Formula III would have been obvious to one skilled in the art. Accordingly, Applicants request withdrawal of this objection.

Rejection under 35 U.S.C. §112 and §101

To overcome the §112, first paragraph, and §101 rejections, claims 56 and 107 have been amended to present claims directed specifically to the disclosed compounds found in the Specification, page 13, lines 1-2, and pages 21-33, Examples 5 and 6.

Specifically, the specification recites as an exemplary preferred compound of Formula III as amended, 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine. Specification, page 13, lines 1-2. In addition, Examples 5 and 6 found on pages 21-23 of the specification illustrate how to make 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine and 3'-azido-3'-deoxy-5'-(dodecyoxy-2-decyloxypropyl)-phosphothymidine.

In the Advisory Action of September 16, 2003, the Examiner states that 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine is not a compound of Formula III and rejects the claims under 35 U.S.C. §101 for lack of support by either a specific asserted utility or a well established utility. For the reasons stated above, the specification fully establishes utility in regard to Formula III.

Similarly, since the claimed invention is supported by established utility, one skilled in the art clearly would know how to use the claimed invention. Uses of compounds of Formula III described throughout the specification, including the efficacy of the compounds of Formula III in combating viral infection. See, specification, page 14, line 20-page 15, line 8. Therefore, the rejections under §§101 and 112 should be withdrawn.

Claims 110-112, which depend upon claim 107, have been added to mirror claims 69-71, which depend upon claim 56. These claims are supported by the Declaration under C.F.R. 1.132 filed on April 30, 2003 and the specification on page 14, line 20 to page 15, line 8, which specifically describes the effectiveness of compounds of Formula III against HIV-1, hepatitis B and herpes simplex virus. No new matter has been added.

CONCLUSION

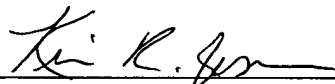
Applicants respectfully request reconsideration of the subject application in view of the above amendments and remarks. The subject application is now in condition for allowance and early notice to that effect is respectfully solicited.

Alternatively, Applicants request that the Examiner immediately schedule an interview to discuss this application.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 
Kim R. Jessam
Reg. No. 43,694

Dated: October 17, 2003

CUSTOMER NO. 028977
MORGAN, LEWIS & BOCKIUS LLP
1701 Market Street
Philadelphia, PA 19103-2921
(215) 963-5000